

## **REMARKS**

The present application includes pending claims 1-48, all of which have been rejected. In particular, claims 1-9, 14-22, 25-27, 29-32, 34-44 and 48 stand rejected under 35 U.S.C. 102(e) as being anticipated by United States Patent No. 7,065,778 (“Lu”). Claims 10-13, 23-24, 28, 33 and 45-47 stand rejected under 35 U.S.C. 103(a) as being unpatentable over Lu in view of United States Patent No. 6,963,358 (“Cohen”). Without conceding that Lu qualifies as prior art under 35 U.S.C. 102(e), the Applicants respectfully traverse these rejections for at least the reasons previously discussed during prosecution and the following:

### **I. Lu Does Not Anticipate The Pending Claims**

Lu “relates to the field of utilizing personalized video recorders and other similar types of devices to distribute television programming.” *See* Lu at column 1, lines 7-11. In particular, Lu discloses a system in which a user is able to record a show that is transmitted in another broadcast area. *See id.* at Abstract.

For example, Lu describes the following:

Specifically, personalized video recorder 200 is coupled to the Internet 302 such that it can receive an electronic programming guide (EPG) containing worldwide television programming from an EPG server computer 304. The user of personalized video recorder 200 utilizes the EPG to request delivery of a specific television show that may not be available to him or her. Upon reception of the request from personalized video recorder 200, EPG server computer 304 locates via Internet 302 one or more personalized video recorders... situated within a broadcast region of the requested television show. Subsequently, EPG server computer 304 programs one or more personalized video recorders... to record the requested television show when it is broadcast by a television content provider.... Once the personalized video recorders... record the television show, one or more of the personalized video recorders may transmit it to EPG server computer 304 which then transmits it to the requested

personalized video recorder 200. In this manner, the present embodiment enables personalized video recorder 200 to order and receive specific television shows that are unavailable from its television content provider....

Lu at column 6, lines 39-61. Thus, Lu discloses a system in which a user sends a recording request that is received by a server computer via the Internet. The server computer then arbitrarily locates a recorder within the broadcast region of the show, and then sends the recorded show back to the requesting user.

Claim 1 recites, in part, “server software that **maintains a user defined association of the first and second network protocol addresses**, that receives a request that identifies one of the associated first and second network protocol addresses and responds by identifying the other of the associated first and second network protocol addresses **to support delivery via the communication network of the 3<sup>rd</sup> party media from the at least one server, and the first media from the first storage, to the second home, and the 3<sup>rd</sup> party media from the at least one server, to the first home, for concurrent consumption of the 3<sup>rd</sup> party media by the first television display, and the 3<sup>rd</sup> party media and the first media by the second television display.**” Lu does not describe, teach, or suggest these limitations. Instead, Lu merely discloses that a user of a PVR requests delivery of a specific television show, at which point a server computer arbitrarily locates another PVR in a particular broadcast area to record the show for the requesting PVR.

The Office Action cites Lu only at column 10, lines 10-15 as disclosing server software “that maintains a user defined association of the first and second network protocol addresses.” See February 15, 2008 Office Action at pages 3, 6-7, 10 and 17. The Applicants respectfully submit, however, that Lu is completely devoid of anything that describes, teaches or suggests

these limitations. Indeed, the Office Action is unable to identify anything in Lu that describes, teaches or suggests such limitations.

The only portion of Lu that the Office Action cites as disclosing these limitations, namely Lu at column 10, lines 10-15, states, however, the following:

Furthermore, the programming instructions of step 512 may also include an Internet Protocol (IP) address of a device (e.g., personalized video recorder 200) that the personalized video recorder (e.g., 200A or 200B) should transmit the requested television show to once it has been recorded.

Lu at column 10, lines 10-15. This portion of Lu merely indicates the IP address of the location to which the recorded show will be sent. This portion of Lu does not, however, describe, teach or suggest “server software that **maintains a user defined association of the first and second network protocol addresses,**” as recited in claims 1, 15 and 35. Thus, for at least these reasons, the Office Action has failed to establish a *prima facie* case of anticipation with respect to claims 1, 15, 35 and the claims that depend therefrom.

Additionally, the Office Action cites Lu **only at column 6, lines 21-28 and 39-61** as disclosing “support[ing] delivery via the communication network of the 3<sup>rd</sup> party media from the at least one server, and the first media from the first storage, to the second home, and the 3<sup>rd</sup> party media from the at least one server, to the first home.” *See* February 15, 2008 Office Action at pages 3-4, 7, 9-10, 11 and 17.

First, Lu at column 6, lines 21-28 states the following:

An optional display device 212 is coupled to bus 210 of personalized video recorder 200 for displaying video and/or graphics. It should be appreciated that optional display device 212 may be a cathode ray tube (CRT), flat panel liquid crystal display (LCD), field emission display (FED), or any other display device suitable for displaying video and/or graphic images and

alphanumeric characters recognizable to a user.

As shown above, this cited portion of Lu merely discloses that a display device, examples of which are recited, is coupled to a bus of PVR. This cited portion of Lu does not describe, teach or suggest, however (nor has the Office explained how it could) “support[ing] delivery via the communication network of the **3<sup>rd</sup> party media from the at least one server, and the first media from the first storage, to the second home**, and the **3<sup>rd</sup> party media from the at least one server, to the first home, for concurrent consumption** of the **3<sup>rd</sup> party media by the first television display, and the **3<sup>rd</sup> party media and the first media by the second television display,**” as recited in claim 1, for example.**

Next, Lu at column 6, lines 39-61 (the only other portion of Lu that the Office Action cites as disclosing the “supporting” limitations) recites the following:

Specifically, personalized video recorder 200 is coupled to the Internet 302 such that it can receive an electronic programming guide (EPG) containing worldwide television programming from an EPG server computer 304. The user of personalized video recorder 200 utilizes the EPG to request delivery of a specific television show that may not be available to him or her. Upon reception of the request from personalized video recorder 200, EPG server computer 304 locates via Internet 302 one or more personalized video recorders (e.g., 200A and/or 200B) situated within a broadcast region of the request television show. Subsequently, EPG server computer 304 programs one or more personalized video recorders (e.g., 200A and/or 200B) to record the requested television show when it is broadcast by a television content provider (e.g., television head-end 308). Once the personalized video recorders (e.g., 200A and 200B) record the television show, one or more of the personalized video recorders may transmit it to the requested personalized video recorder 200. In this manner, the present embodiment enables personalized video recorder 200 to order and receive specific television shows that are unavailable from its television content provider (e.g., 306).

*See* Lu at column 6, lines 39-61. The “request” mentioned in this passage is a “request [for]

delivery of a specific television show that may not be available to him or her.” *See id.* at column 6, lines 43-45. As this cited portion makes clear, in response to the request for delivery, the EPG server “locates one or more personalized video recorders situated within a broadcast region of the requested television show.” Location of a recorder within a particular broadcast region in response to a request for delivery of a particular television show is not a response to a request that “identif[ies] the other of the associated first and second network protocol addresses to support delivery,” as recited in claim 1, for example. Moreover, there is nothing in this passage, or the rest of Lu, that describes, teaches or suggests “support[ing] delivery via the communication network of the **3<sup>rd</sup> party media from the at least one server, and the first media from the first storage, to the second home, and the 3<sup>rd</sup> party media from the at least one server, to the first home, for concurrent consumption** of the **3<sup>rd</sup> party media by the first television display, and the **3<sup>rd</sup> party media and the first media by the second television display,**” as recited in claim 1.**

The Applicants respectfully submit that Lu does not describe, teach or suggest “server software that **maintains a user defined association of the first and second network protocol addresses**, that receives a request that identifies one of the associated first and second network protocol addresses and responds by identifying the other of the associated first and second network protocol addresses **to support delivery via the communication network of the **3<sup>rd</sup> party media from the at least one server, and the first media from the first storage, to the second home, and the 3<sup>rd</sup> party media from the at least one server, to the first home, for concurrent consumption of the **3<sup>rd</sup> party media by the first television display, and the **3<sup>rd</sup> party media and the first media by the second television display,******”**

**party media and the first media by the second television display,”** as recited in claim 1, for example. Thus, for at least these reasons, Lu does not anticipate claims 1-9 and 14.

Independent claim 15 also recites “server software that maintains a user defined association of the first and second protocol addresses, that receives a request that identifies one of the associated first and second protocol addresses and responds by identifying the other of the associated first and second protocol addresses to support delivery via the communication network of the 3rd party media from the at least one server and the first media from the first storage, to the second television display for concurrent consumption of the 3rd party media and the first media.” For at least the reasons discussed above with respect to claim 1, the Applicants respectfully submit that Lu does not anticipate claims 15-22.

Independent claim 25 recites, in part, “set top box circuitry, in the second home, communicatively coupled to receive the first media from the first storage and the 3<sup>rd</sup> party media from the at least one server, for concurrent consumption by the second television display,” and “server software that coordinates delivery via the communication network of the first media from the first storage and the 3rd party media from the at least one server to the set top box circuitry.” As discussed above, Lu does not describe, teach or suggest receiving first media from a first storage and 3<sup>rd</sup> party media from at least one server, for concurrent consumption by a television. Thus, for at least these reasons, Lu does not anticipate claims 25-27 and 29.

## **II. The Proposed Combination Of Lu And Cohen Does Not Render Claims 10-13, 23-24 And 28 Unpatentable**

The Applicants now turn to the rejection of claims 10-13, 23-24 and 28 as being unpatentable over Lu in view of Cohen. The proposed combination of references does not render these claims unpatentable for at least the reasons discussed above.

### **III. Claims 30-48 Are Also In Condition For Allowance**

Claims 30-48 recite similar limitations to those noted above. Thus, the Applicants respectfully submit that the Office Action has not established a *prima facie* case of anticipation or obviousness with respect to any of these claims for at least some of the reasons discussed above.

### **IV. Conclusion**

The Office Action states the following:

Examiner has cited particular paragraphs, figures, columns and line numbers in the references as applied to the claims above for the convenience of the applicant. Although the specified citations are representative of the teachings in the art and are applied to the specific limitations within the individual claim, other passages and figures may apply as well. It is respectfully requested from the applicant, in preparing the responses, to fully consider the references in entirety as potentially teaching all or part of the claimed invention, as well as the context of the passage as taught by the prior art or disclosed by the examiner.

*See* February 15, 2008 Office Action at page 18. Nevertheless, this general, blanket statement does not relieve the Examiner from establishing a *prima facie* case of anticipation or obviousness with respect to the pending claims if the Examiner intends to reject the claims. The Applicants note that if a *prima facie* case of anticipation or obviousness is not established, the Applicants are under no obligation to submit evidence of nonobviousness.

The examiner bears the initial burden of factually supporting any *prima facie* conclusion of obviousness. If the examiner does not produce a *prima facie* case, the applicant is under no obligation to submit evidence of nonobviousness.

*See* MPEP at § 2142.

It is not enough for the Examiner to generally cite a reference and then leave it up to the Applicants to make out a *prima facie* case for the Examiner. In the present application, the Applicants have even demonstrated that the portions of Lu that the Office Action relies on do not describe, teach or suggest the relevant claim limitations. As such, the burden shifts back to the Examiner to try to establish a *prima facie* case of anticipation or obviousness. Regardless, the Applicants are confident that Lu, alone or in combination with Cohen, does not describe, teach or suggest the limitations discussed above.

As noted above, the Applicants respectfully submit that the Office Action has not established a *prima facie* case of anticipation or obviousness with respect to any of the pending claims. Indeed, the Office Action seems to acknowledge that the arguments set forth in the February 15, 2008 Office Action are not entirely persuasive. *See* February 15, 2008 Office Action at page 16 (“Applicants arguments field [sic] on 28 November 2007 have been fully considered but they are not persuasive. **However, because there exists the likelihood of future presentation of this argument,** the Examiner thinks that it is prudent to address applicant’s main point of contention.”).

If, however, the Examiner intends to maintain these rejections, **the Applicants respectfully request an interview with the Examiner and the Examiner’s supervisor.**

In general, the Office Action makes various statements regarding the pending claims and the cited references that are now moot in light of the above. Thus, the Applicants will not address such statements at the present time. The Applicants expressly reserve the right, however, to challenge such statements in the future should the need arise (e.g., if such statement should become relevant by appearing in a future claim rejection).

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Response Under 37 C.F.R. § 1.116  
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The Applicants respectfully submit that the Office Action has not established a *prima facie* case of anticipation or obviousness with respect to any of the pending claims for at least the reasons discussed above and request that the outstanding rejections be reconsidered and withdrawn. **Nevertheless, the Applicants invite the Examiner to contact the undersigned attorney to discuss potential amendments that will lead to an allowance in order to avoid an appeal to the Board of Patent Appeals and Interferences.** If the Examiner has any questions or the Applicants can be of any assistance, the Examiner is invited to contact the undersigned attorney for Applicants.

The Commissioner is authorized to charge any necessary fees or credit any overpayment to the Deposit Account of McAndrews, Held & Malloy, Account No. 13-0017.

Respectfully submitted,

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